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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,384	09/01/2000	Steven L. Sholem	6299-A-01	7084
23123 7590 03/07/2007 SCHMEISER OLSEN & WATTS 18 E UNIVERSITY DRIVE SUITE # 101 MESA, AZ 85201			EXAMINER BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/653,384

Applicant(s)

SHOLEM, STEVEN L.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39,42-51 and 53-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39, 42-51, and 53-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed on 6 December 2006.

Claims 39, 42-51, and 53-62 are pending. Claim 39 has been amended. Claim 62 is newly added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 39, 42-51, and 53-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 39 recites "a processor operating in accordance with software for: . . . accessing data indicative of the historical payment patterns of the TPP to one or more medical service providers from which a net present value of a future payment by the TPP *for at least one future medical service* for a patient associated with the TPP may be generated." Claim 39 requires that "a future medical service" be determined and it appears that the processor must perform this step. However, Applicant's specification

fails to describe how the processor is able to determine a future medical service for a patient. It is not clear if the patient is making a diagnosis when the patient calls the medical service provider to make an appointment. For example, the specification fails to describe what happens if the patient states that they believe they are suffering from ailment X, but in reality upon seeing the patient, the doctor actually diagnoses the patient with disease Y. Disease Y could be much more costly to treat. At this point, the medical service provider would have accepted the patient because the NPV was adequate for ailment X, but in reality this patient should not have been accepted. Because the specification fails to describe any steps that the processor would perform to determine a "future medical service for a patient," claim 39 fails to comply with the enablement requirement.

Further, claim 39 recites "generating an indication of when a patient is accepted as a new patient based in part on the NPV." However, the specification fails to describe when an indication of acceptance is generated based on the NPV. For example, the specification fails to describe what thresholds are used to indicate that a patient is accepted as a new patient. In addition, claim 39 recites "generating an indication of when the patient's requested appointment should be scheduled, based in part on the net present value, after the new patient is accepted or not accepted." The specification fails to describe a correlation between a particular NPV for a medical service and the indication of a scheduled appointment time. By failing to describe this information in the specification in such a way as to enable one skilled in the art to which it pertains to

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make and/or use the invention, Applicant has failed to comply with the enablement requirement.

Claims 42-51 and 53-61 incorporate the deficiencies of claim 39 through dependency, and are therefore rejected.

Similar analysis applies to claim 62, and thus claim 62 is rejected for the same reasons as claim 39. In addition, claim 62 recites "wherein the software is configured to generate a recommended duration for a primary medical personnel to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers." The specification fails to describe a correlation between a particular payment pattern of a TPP and a recommended duration for an appointment time. For example, what types of calculations or analyses are performed by the processor to determine the duration. By failing to describe this information in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention, Applicant has failed to comply with the enablement requirement.

4. Claims 39, 42-51, and 53-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant states at page 10 of the amendment filed on 6 December 2006 that the newly added limitations of

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"generating an indication of when the patient's requested appointment should be scheduled, based in part on the net present value" finds support on page 20, lines 1-3. However, this portion of the specification states "According to a second aspect of the present invention, the relative value of medical services to be provided for a patient is calculated and considered as a factor in a determination of scheduling the patient for an appointment." The cited portion does not support a processor "generating an indication of when the patient's requested appointment should be scheduled." This portion only supports that the NPV is a factor in determining when to schedule a patient. Further, Applicant has failed to provide support for "generating an indication of when a patient is accepted as a new patient based in part on the net present value" as recited in claim 39. Applicant has also failed to provide support for "generating an indication of when the patient's requested appointment should be scheduled, based in part on the net present value, after the new patient is accepted or not accepted as a new patient." The Examiner requests that Applicant provide support for all of the newly added limitations in claims 39 and 62. Claims 42-51 and 53-61 incorporate the deficiencies of claim 39 through dependency, and are therefore rejected.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 39, 42-51, and 53-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 39 and 62 recite "generating an indication of when a patient is accepted as a new patient based in part on the NPV." Is this indication only generated for new patients or is this indication generating for all patients, including those already seen by the medical service provider? Appropriate clarification is requested.

Claim 39 recites "generating an indication of when the patient's requested appointment should be scheduled, based in part on the net present value, after the new patient is accepted or not accepted." It is noted that if the patient is not accepted, then this step is never performed. It is unclear if this is what Applicant intends to claim. For purposes of applying prior art, the Examiner interprets claim 39 to be performed based on a patient that is not accepted. Thus, this last limitation will not be performed because the patient has not been accepted. Similar analysis applies to step 5 in claim 62. It is noted that the software never generates a recommended duration for an appointment if the patient is not accepted. Thus, for purposes of applying prior art, the Examiner interprets claim 62 to not require an appointment duration to be generated because the patient has not been accepted.

Claims 42-51 and 53-61 incorporate the deficiencies of claim 39 through dependency, and are therefore rejected for the same reasons.

NOTE: The following rejections assume that the subject matter added in 12/6/06 amendment is adequately supported in the originally filed specification, and are

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provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the 112, 1st paragraph rejections made in preceding sections above in the next communication sent in response to the present Office Action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 39, 42-51, 53, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keyes et al. (6,456,983) in view of Jones (6,044,351) and Evans (5,924,074), for substantially the same reasons given in the previous Office Actions (dated 7/6/2006 and 1/27/2006). Further reasons appear below.

(A) Claim 39 has been amended to recite "generating an indication of when a patient is accepted as a new patient based in part on the net present value."

As per this limitation, Keyes discloses generating a recommendation of when an account should be accepted or declined based in part on the net present value (Fig. 6, col. 9 line 65 to col. 10 line 19). Keyes does not disclose the account relating to "a patient." However, Evans teaches that it is well known to schedule a patient for an appointment with a healthcare provider. Evans discloses enabling a healthcare provider to schedule a patient appointment using a point and click interface by selecting an

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appointment data and an appointment time, and wherein the healthcare provider can review prior or future scheduled appointments by clicking on an appointment button (Figure 2, col. 5 line 29 to col. 6 line 9).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Keyes and Jones with the motivation of quickly and efficiently capturing patient data (Evans; col. 2 lines 20-45) and automatically determining whether to accept or decline an account (or patient) (see Keyes; col. 9 line 65 to col. 10 line 19).

As per the recitation of "generating an indication of when the patient's requested appointments should be scheduled, based in part on the net present value, after the new patient is accepted or not accepted," the Examiner respectfully submits claim 39 is being interpreted as the patient not being accepted in step (4) and thus, step (5) is never performed. (See the rejection of claim 39 above under 35 U.S.C. § 112, second paragraph). Because step (5) is not performed, prior art has not been provided with regards to this limitation.

The remaining features are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(B) Claims 42-51, 52, and 56-61 have not been amended, and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

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9. Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keyes et al. (6,456,983) in view of Jones (6,044,351) and Evans (5,924,074), as applied to claim 39, and further in view of Rensimer et al. (5,845,253), for substantially the same reasons given in the previous Office Actions (dated 7/6/2006 and 1/27/2006). Further reasons appear below.

(A) Claims 54-55 have not been amended, and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

10. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keyes et al. (6,456,983) in view of Jones (6,044,351) and Evans (5,924,074).

(A) As per claim 62, Keyes discloses a method for evaluating an offer which has been made in relation to certain delinquent accounts comprising:

(a) a desktop computer with a computer readable storage medium, wherein the computer outputs data (Fig. 6, col. 4 lines 42-67), wherein the computer is configured to:

1) receive an offer associated with a current account (Fig. 5, col. 8 lines 7-38);

2) evaluate the offer by retrieving an appropriate collection of historical data based upon analysis of the historical data, identifying basis for dividing the retrieved collection of historical data into a plurality of groups, obtaining information on

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the payment history of each of these groups, processing this information and making a recommendation on the disposition of the account (Abstract; col. 4 line 42 to col. 5 line 10);

3) calculating the net present value of each portion of the portfolio based on the historical information (Abstract; col. 9 line 38 to col. 10 line 19); and

4) generating a recommendation of when an account should be accepted or declined based in part on the net present value (Fig. 6, col. 9 line 65 to col. 10 line 19).

Keyes fails to expressly disclose a system related to the health care environment.

Jones discloses a system for predicting the probability distribution of a health care facility's predicted future minimum income for a total time interval (Abstract; col. 13 line 45 to col. 14 line 36).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Jones within the system of Keyes with the motivation of allowing a physician to predict future health care income to plan for the "worst care" scenario (Jones; col. 1 lines 10-20).

Keyes does not disclose the account relating to "a patient" with regards to step (4).

Evans discloses enabling a healthcare provider to schedule a patient appointment using a point and click interface by selecting an appointment data and an appointment time, and wherein the healthcare provider can review prior or future

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scheduled appointments by clicking on an appointment button (Figure 2, col. 5 line 29 to col. 6 line 9).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Keyes and Jones with the motivation of quickly and efficiently capturing patient data (Evans; col. 2 lines 20-45) and automatically determining whether to accept or decline an account (or patient) (see Keyes; col. 9 line 65 to col. 10 line 19).

As per the recitation of "software configured to generate an indication of when a patient's appointment should be scheduled, based in part on the net present value, after the new patient is accepted or not accepted as a new patient, wherein the software is configured to generate a recommended duration for a primary medical personnel to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers," the Examiner respectfully submits claim 62 is being interpreted as the patient not being accepted in step (4) and thus, step (5) is never performed. (See the rejection of claim 62 above under 35 U.S.C. § 112, second paragraph). Because step (5) is not performed, prior art has not been provided with regards to this limitation.

Response to Arguments

11. Applicant's arguments filed 6 December 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed on 6 December 2006.

(A) At pages 10-11 of the response filed on 6 December 2006, Applicant argues that the prior art fails to teach the newly added limitations.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 6 December 2006 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Keyes, Jones, Evans, and/or Rensimer, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Actions (dated 7/6/2006 and 1/27/2006), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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(B) At pages 11-12 of the response filed on 6 December 2006, Applicant argues that the applied prior art, namely Rensimer, fails to teach the limitations of claim 54. This limitation has been incorporated into independent form in claim 62.

In response, the Examiner respectfully submits that the combination of Keyes and Rensimer teach the limitation of claim 54. Keyes teaches generating a recommendation of when an account should be accepted or declined based in part on the net present value (Fig. 6, col. 9 line 65 to col. 10 line 19) and Evans teaches enabling a healthcare provider to schedule a patient appointment using a point and click interface by selecting an appointment data and an appointment time, and wherein the healthcare provider can review prior or future scheduled appointments by clicking on an appointment button (Figure 2, col. 5 line 29 to col. 6 line 9) as discussed in the rejection of claim 39. Rensimer discloses using a CPT clinical status code used by a health care provider, wherein the CPT code has an associated standard amount of time for a provider to interact with a patient (col. 4 lines 24-33). It is noted that the amount of time for a provider to interact with a patient must be based at least in part on the "historical payment patterns of the TPP to the one or more medical service providers." For example, the amount of time associated with a CPT code is based on historical data. Over time, insurance companies have had to determine that a new patient encounter will require ten minutes (col. 4 lines 34-46 of Rensimer). Further, the length of time for an appointment associated with a particular CPT is also based on how much an insurer will actually pay for the particular medical procedure associated with the CPT code. This is a form of "historical payment pattern" (i.e., how much insurers have paid over

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time to medical providers). Thus, the combination of Keyes, Jones, Evans, and Rensimer teaches the limitation of claim 54, and thus the rejection under 35 U.S.C. § 103(a) was proper.

(C) At pages 12-13 of the response filed on 6 December 2006, Applicant argues that the Examiner relies on hindsight reconstruction in her determination that Applicant's invention is obvious under 35 U.S.C. § 103(a). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches method and apparatus for generating segmentation scorecards for evaluating credit risk of bank card applicants (6,202,053).

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

15. Any response to this action should be mailed to:

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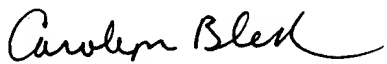
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(571) 273-6767 [Informal/ Draft communications, labeled
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Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.


Carolyn M. Bleck
Patent Examiner
Art Unit 3626

2/27/07